

REMARKS

After entry of the foregoing amendment, claims 1-5, 8-12 and 16-21, 24, and 28-39 are pending in the application. Claims 38-40 are newly added

The allowance of claims 1-5, 11, 16, 19, 21, 24, 28-32, 36 and 37 is noted with appreciation (as is the indication of allowable subject matter in claims 33 and 34).

The § 112 rejection of claim 20 is respectfully traversed. Instead of “comprising,” applicants have used the term “wherein.”

New claim 38 is modeled after claim 20, but is phrased in Jepson format. Additionally, a further limitation has been added to the end of the claim.

The rejection of claim 8 is respectfully traversed, on the same grounds as earlier stated.

The Office bases the rejection of claim 8 on a “broadest reasonable interpretation” theory.¹ However, seven days after the present Action was mailed, the Federal Circuit issued a precedential opinion (*In re Johnston*) that applied the principles of *Phillips v. AWH* to examination – requiring the Office to give claim terms the meanings imparted by applicant’s specification, rather than other possible meanings.

When the language of claim 8 is given meaning imparted by applicants’ specification, it will be seen that Messing’s arrangement is not encompassed.

New claim 39 is modeled after claim 8, but includes a concluding clause specifying that the printed substrate has the hidden reference signal formed thereon.

If claim 39 is found allowable, applicants would be willing to cancel claim 8, and amend other claims into independent form (e.g., for objected-to claim 33), or to depend from claim 39 (e.g., for rejected claims 9, 10, and 35). If claim 39 is rejected, applicants will argue the patentability of both claims on appeal.

Claim 12 – written in “means plus function” form – is rejected over Howell. Applicants continue their earlier traverse. For example, Howell does not perform “in

¹ January 23, 2006, Action, page 2, 2nd line from bottom.

substantially the same way" as the "means for determining" detailed in the present specification. The present specification teaches, e.g., that the means for determining image alignment proceeds by reference to information steganographically encoded in the

subject from which the image is captured. Howell's arrangement doesn't perform in the same way, nor in substantially the same way.

This failure of Howell to employ information steganographically encoded in the subject was not addressed or acknowledged in the Action. (It is not sufficient, in construing § 112 § 6 claim language, that Howell results in a tolerance of a single pixel. That considers just the result – not the "way" the result is achieved.) The Action states that Howell "*is sufficient to meet the claim limitation even with 112 sixth paragraph invoked*" but gives no rationale for such assertion. Reconsideration is solicited.

As with claim 8, the prior traverse of the rejection of claim 17 is maintained, but applicants have submitted a similar new claim – 40 – with further limitations (see the last claim clause). If claim 40 is found allowable, applicants will cancel claim 17. If claim 40 is rejected, both claims will be appealed.

Favorable reconsideration and passage to issuance are solicited.

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Respectfully submitted,

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